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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PILLAI, NAMITHA

ART UNIT PAPER NUMBER

2173

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,651

Applicant(s)

NAKAI ET AL.

Examiner

Namitha Pillai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 is/are pending in the application. R3
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 3 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by U. S. Patent No. 5,546,527 (Fitzpatrick et al.), herein referred to as Fitzpatrick.

Referring to claim 3, Fitzpatrick discloses a print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of the file being executed under the predetermined print conditions in the print icon by dragging the file icon and dropping the file icon on the print icon (Figure 4 and column 1, lines 21-30). Fitzpatrick discloses that the print conditions in the print icon are displayed on the display picture in a recognizable display form (Figure 4 and column 2, lines 11-13). Fitzpatrick discloses at a time point a file icon of a file to be printed is superposed on the print icon, a printing preview of the file icon is displayed on the display picture, wherein the print parameters which apply to the file icon for printing inherently teaches a preview means for the previewing of the file icon (Figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,546,527 (Fitzpatrick et al.), herein referred to as Fitzpatrick and U. S. Patent No. 5,638,505 (Hemenway et al.), herein referred to as Hemenway.

Referring to claim 1, Fitzpatrick discloses a print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of the file being executed under the predetermined print conditions in the print icon by dragging the file icon and dropping the file icon on the print icon (Figure 4 and column 1, lines 21-30). Fitzpatrick discloses that print icon is formed so that the display is altered to a setting of the print conditions, wherein the print icon is formed to have default print conditions (column 1, lines 27-30). Fitzpatrick also discloses the predetermined print conditions in the print icon being displayed on the display picture in a recognizable display form (Figure 4 and column 2, lines 11-13) but discloses that the print conditions are displayed by locating the file icon on the print icon. Hemenway carries out the same methods as disclosed by Fitzpatrick of dragging and dropping a file icon on to a print icon in order to print the contents of the file icon (column 1, lines 65-67 and column 2, lines 1-5). Hemenway in addition to that, also displays the print conditions in a recognizable display form without having to locate the file icon on the print icon, wherein this print information is always displayed (reference number 46, Figure 3A). It would have been obvious for one skilled in the art, at the time of the invention to display the print conditions in a recognizable display form without having to locate the file icon on the print icon. Hemenway and Fitzpatrick both teach printing files through icon manipulation, wherein a file icon is dragged and dropped onto a print

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icon in order for that distinct printer to print the file. Hemenway furthermore allows for the user to view the print conditions without an additional dragging process, wherein this convenient method can be beneficial in Fitzpatrick's disclosure, wherein the user can view the print conditions before dragging the file icon.

Referring to claim 2, Fitzpatrick discloses that at a time point when a file icon of a file to be printed is superposed on the print icon, an outline of the print conditions preset in the print icon are displayed on the display picture (Figure 4 and column 2, lines 32-37).

Referring to claim 4, Fitzpatrick does not explicitly imply a plurality of file icons of files to be printed being dragged and dropped on the printer icon. Hemenway much like Fitzpatrick, allows for a drag and drop means for dragging file documents and dropping them onto print icons for printing to occur, wherein Hemenway goes further to display to teach that multiple print jobs are applicable to the one print icon (Figure 3C and column 1, lines 7-13). It would have been obvious for one skilled in the art, at the time of the invention to learn from Hemenway to implement a means for a plurality of file icons of files to be printed by dragging and dropping the files onto the print icon, thee files being consecutively printed as a series of recorded matters. It is necessary to have a method for printing various documents, which is necessary for users of any computer system. Thus, as Hemenway teaches, the ability to drag and drop a plurality of documents on to the print source or icon allows for the print jobs to be queued to be processed consecutively, thus allowing for various documents to be printed at the same time.

Referring to claim 5, Fitzpatrick discloses when a file icon of a file to be printed is dragged and dropped on the print icon, a window for setting print conditions of the print icon is opened (column 2, lines 47-50 and Figure 4).

Referring to claim 6, Fitzpatrick discloses when a file is dragged and dropped on the print icon, a printer capable of conducting print processing is automatically selected based on print conditions set in the print icon, wherein once the file icon is dropped onto a print icon, from within the parameters disclosed, the specific printer is determined (column 4, lines 1-4).

Referring to claim 7, Fitzpatrick discloses when a file icon is dragged and dropped on the print icon, a printer capable of conducting a print processing is automatically selected from among printers in a stand-by state, based on print conditions set in the print icon (column 3, lines 58-60 and column 4, lines 1-4).

Referring to claim 8, Fitzpatrick discloses a printer to be used is set in the print icon as one of set conditions of the print icon (column 4, lines 1-4). Fitzpatrick discloses monitoring the target print icons to determine if the state of the printer is monitored such that the printer cannot execute processing set in the print icon, the print icon is controlled so as not to display (column 6, lines 8-19).

Referring to claim 9, Fitzpatrick discloses a print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of the file being executed under the predetermined print conditions in the print icon by dragging the file icon and dropping the file icon on the print icon (Figure 4 and column 1, lines 21-30). Fitzpatrick discloses creating a print icon having new print conditions set therein for the print icon (column 2, lines 32-37).

Fitzpatrick does not clearly disclose there being a plurality of print icons. It would have been obvious for one skilled in the art, at the time of the invention to learn to implement a means for a plurality of icons of files to represent various print conditions. It is necessary to have a method

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for printing various documents, to various printers, the various printers represented by the print icons, which is necessary for users of any computer system to have access to more printing abilities. This allows for many more print jobs to be accomplished at a faster pace, hence it would have been obvious for one skilled in the art at the time of the invention to have a plurality of icons representing various print conditions, wherein various documents can be printed based on the many print conditions options given.

Referring to claim 10, Fitzpatrick discloses at a time point a file icon of a file to be printed is superposed on the print icon, a printing preview of the file icon is displayed on the display picture, wherein the print parameters which apply to the file icon for printing inherently teaches a preview means for the previewing of the file icon (Figure 4).

Response to Claim Changes

3. The Examiner acknowledges Applicant's amendments to claims 1 and 3 and the addition of new claim 10. However all claims are rejected under 35. U. S. C. 102 and 103 as being previously disclosed in prior art.

Response to Arguments

4. Applicant's arguments filed 1/20/04 have been fully considered but they are not persuasive.

With respect to Applicant's arguments that Fitzpatrick fails to disclose a printing preview of the file icon is displayed on the display picture. The print preview may display such printer parameters, but these printer parameters are previews that apply to the file icon being printed and hence are inherently part of the file icon or apply to the file icon and are a print preview of the

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file icon. The user is able to access a print preview of the parameters that would apply to the file icon and hence get a preview.

With respect to Applicant's arguments that Fitzpatrick fails to disclose that a print icon is created having print conditions, when a predetermined plurality of print icons displayed on the display screen and respectively having different print conditions are coupled. Fitzpatrick clearly allows for print icons to be created with new print conditions based on allowing the users to change the default values. Fitzpatrick may not specifically disclose a plurality of print icons displayed, but it is inherent and obvious as stated in the rejection that a user interface would have a plurality of print icons each having different print conditions based on the choices made by the user and wherein the print icons are coupled to the file icons, wherein as stated in Fitzpatrick the files icons are dragged and dropped on the print icons, thereby showing a coupling relationship. As currently stated in the arguments, as to Fitzpatrick failing to disclose coupling a plurality of different printer icons in order to create a new printer icon. It is unclear as to whether the coupling of the printer icons is with each other or other components that the printer icons are related to such as the file icons, as it is not clearly stated that the printer icons are coupled with each other. Furthermore, claim 9 simply states two methods that are inherently part of Fitzpatrick, one being changing the printing conditions and the other being a plurality of print icons respectively having different print conditions that are coupled, wherein a clear distinct relationship between them, wherein one would cause the other has not been clearly established in claim 9.

Conclusion

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5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington D.C. 20231. If applicant desires to fax a response, central FAX number (703) 872-9306 may be used. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed. Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document. Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namitha Pillai whose telephone number is (703) 305-7691. The examiner can normally be reached on 8:30 AM - 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Namitha Pillai
Assistant Examiner
Art Unit 2173
March 30, 2004



RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173